

REMARKS

Claims 1-31, 58 and 59 are pending in this application. Claim 1 is amended. No new matter is believed to be added by this response. Applicants submit that all of the claims are now in a form for allowance.

Claim Rejections – 35 U.S.C. § 102

In the Office Action, claims 1-11, 14, 15, 17, 19-25, 29, 30, 58 and 59 were rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al. (US 2002/0056118).

Claim 1 is an independent claim from which claims 2-11, 14, 15, 17, 19-25, 29, 30, 58 and 59 depend either directly or indirectly.

A proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). The test is the same for a process. Anticipation requires identity between the claimed process and a process of the prior art. The claimed process, including each step thereof, must have been described or embodied, either expressly or inherently, in a single reference. *See, e.g., Glaverbel S.A. v. Northlake Mkt'g & Supp., Inc.*, 45 F.3d 1550, 33 USPQ2d 1496 (Fed. Cir. 1995). Those elements must either be inherent or disclosed expressly. *See, e.g., Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). In summary, the single prior art reference must properly disclose, teach or suggest each element of the claimed invention. Moreover, “every element of the claimed invention must be literally present, arranged as in the claim. ... The identical invention must be shown in as complete detail as is contained in the patent claim.” *See, e.g., Richardson v. Suzuki Motor Company Co.* 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicants submit that every feature of the above-identified claims is not present in Hunter.

I. Independent Claim 1

Amended Claim 1 of the present application provides as follows:

A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:

a memory for storing recordable media content characterizing information;

a storage device capable of storing on a plurality of portable storage medium, wherein each portable storage medium is one of a plurality of different portable storage medium types; and

a processor configured with the memory to:

receive into the memory the characterizing information corresponding to respective recordable media content;

provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content;

download the first recordable media content via the subscriber network from a server responsive to a first user input selecting an identifier of the first recordable media content from the user interface;

select without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content; and

store on the selected at least one of the plurality of portable storage mediums of the plurality of different portable storage medium types the downloaded first recordable media content, the at least one of the plurality of portable storage mediums corresponding to

the category of the first recordable media content. (Emphasis in bold added.)

Applicants respectfully request that the rejection of independent claim 1 be withdrawn for at least the reason that *Hunter* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 1.

The Office Action alleges that *Hunter* discloses a processor configured to “select without user intervention (the examiner notes that the CPU 80 selects the CD or DVD in the platter for storage) (p.5, paragraphs 64, 65 and Fig. 4), a portable storage medium type from the plurality of portable storage medium types, the selected portable storage medium type corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content (CD’s are used for CD quality music recordings and DVD’s are used for storage of movies) (p.8, paragraph 126).”

Hunter teaches that:

“Decoded preselected movie data is transmitted via CPU 80 to a high speed memory buffer 84 (with or without high capacity storage capability) and then written to a high density record/playback drive 86, such as a DVD drive associated with the DVD platter.” (Page 5, paragraph [0065]).

And that

Once the purchase selection is made, the recording preferably is written to a conventional CD so that it may be played back on conventional home or auto playback devices. To this end, user station 28 may include positions for holding and writing to conventional CD’s – in addition to the ability to write to another medium such as DVD or magneto-optical discs used for storage of movies.” (Page 8, paragraph [0126].)

Applicants respectfully submit that there is no disclosure, teaching or suggestion that the CPU 80 “selects without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected

portable storage medium type, corresponding to a category of the first recordable media content.” As indicated above, the CPU 80 transmits decoded preselected movie data (and presumably music data) to a high speed memory buffer, but there is no disclosure or teaching in Hunter that the CPU 80 selects, without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type corresponding to a category of the first recordable media content.

Even assuming, *arguendo*, that Hunter discloses the CPU selecting the CD or DVD in the platter for storage, Hunter does not disclose or teach “select without user intervention a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type ... corresponding to a category of the first recordable media content.” Assuming, *arguendo*, that Hunter discloses choosing a medium type (DVD or CD) based upon whether the media content is a movie or music, Hunter does not disclose selecting a medium type and at least one of the portable storage mediums of the selected medium type corresponding to a category of the media content. For instance, if the media content was a drama (the category) movie, then Hunter does not disclose selecting a DVD for storing a movie (medium type) *and* selecting one or more DVD’s designated for storing drama movies (whereas other DVD’s may be designated for storing sporting events, action movies, or other genres), as recited in claim 1. This functionality is described at least on page 10, paragraph [0081] of the present application, and is not found in Hunter:

“As illustrated, extended library functionality comprises the capability to not only to catalog media content but each individual medium (i.e., a CD disc or DVD disc) loaded in the carousel or magazine drive of secondary storage device 414 (FIG. 4) by the type (or category) of data stored on them. Category information may comprise, for example, types of music (such as classical, rock, or jazz), types of movies (such as comedy, drama, or horror), or types of software (such as games, word processing, or utilities).”
(Rodriguez et al., page 10, paragraph [0081].)

Hunter does not disclose selecting at least one of the portable storage mediums of the selected portable storage medium type corresponding to a category. Nor does Hunter teach or suggest selecting at least one of the portable storage mediums of the selected portable storage medium type based upon a category. Therefore, Hunter does not teach or suggest a processor configured to **"select without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content"** as recited in claim 1.

For at least the reasons described above, Hunter fails to disclose, teach or suggest all of the features recited in claim 1. Therefore, Applicants respectfully submit that the rejection of claim 1 be withdrawn.

2. Claims 2-11, 14, 15, 17, 19-25, 29, 30, 58 and 59

Because claim 1 is allowable over Hunter, dependent claims 2-11, 14, 15, 17, 19-25, 29, 30, 58 and 59 are allowable as a matter of law for at least the reason that at each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of claims 2-11, 14, 15, 17, 19-25, 29, 30, 58 and 59 be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 12, 13, and 16 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hunter in view of Hassell et al.

Claims 18 and 26 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hunter in view of LaJoie et al. ("LaJoie," U.S. Pat. No. 5,850,218).

Claims 27 and 28 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hunter in view of Browne, et al. ("Browne," International Publication No. WO 92/22983).

Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Hunter in view of Russo ("Russo," U.S. Pat. No. 5,619,247). Applicants respectfully traverse all the above rejections.

Applicants first submit that, for a *prima facie* case of obviousness, the cited prior art references (when combined) "must teach or suggest all the claim limitations" MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness, can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

1. Claims 12, 13 and 16

As described above, Applicants respectfully submit that Hunter fails to disclose, teach, or suggest at least the features of a processor configured to **"select without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content"** as recited in claim 1. The addition of Hassell fails to remedy these deficiencies. Since dependent claims 12, 13 and 16 incorporate these same features found in independent claim 1, Applicants respectfully submit that claims 12, 13 and 16 are allowable over Hunter in view of Hassell.

2. Claims 18 and 26

As described above, Applicants respectfully submit that Hunter fails to disclose, teach, or suggest at least the features of a processor configured to **"select without user intervention,**

a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content" as recited in claim 1. The addition of LaJoie fails to remedy these deficiencies. Since dependent claims 18 and 26 incorporate these same features found in independent claim 1, Applicants respectfully submit that claims 18 and 26 are allowable over Hunter in view of LaJoie.

3. Claims 27 and 28

As described above, Applicants respectfully submit that Hassell fails to disclose, teach, or suggest at least the features of a processor configured to **"select without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content"** as recited in claim 1. The addition of Browne fails to remedy these deficiencies. Since dependent claims 27 and 28 incorporate these same features found in independent claim 1, Applicants respectfully submit that claims 27 and 28 are allowable over Hunter in view of Browne.

Moreover, Applicants respectfully submit that Hunter in view of Browne fails to teach, disclose, or suggest **"authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert the user to a requirement for authorized access"** as recited in claim 28. The Office Action acknowledges that "Hunter et al. does not disclose that at least one of the recordable media content on the plurality of portable storage mediums located in the storage device have authorized access locks, wherein the authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert the user to a requirement for authorized access." (Office Action, page 10).

The Office Action alleges that "Browne et al. still further discloses displaying an icon to the user indicated that a program is locked (Fig.6)." However Browne teaches, in reference to FIG. 6, that:

When the stored program list 600 is displayed, **the user may lock certain of the listed stored programs. Locking a program involves selecting a program from the list and marking it as locked. A locked program will not be erased** regardless of the program storage mode selected in the program storage option 301 selected in setup page 300, shown in Fig. 3. ...

The user can also set a filter on the stored program list, for example, to restrict the list of programs output on the stored program list 600 to those of interest to a single viewer. If there are two users of the multi-source recorder player 100, it is possible for each to view only his or her own listings and not those of the other person. **This can be preformed by incorporating a user password. ...**

The multi-source recorder player 100, when operated as a multi-user device, will ask the user his or her password before making any menus or screens available. Once the password is received the multi-source recorder player 100 will interface with the user in the same way as described above, ...

(Pages 25-26). Browne does not teach use of icons to alert the user of access locks, but rather entering a password before displaying restricted programs. Browne also appears to disclose using icons to prevent erasing programs. Therefore, Browne fails to teach or suggest **"authorized access locks have corresponding icons displayed on one of a plurality of screen displays to alert the user to a requirement for authorized access"** as recited in claim 28.

For at least the reasons described above, Hunter in view of Browne fails to disclose, teach or suggest all of the features recited in claims 27 and 28. Therefore, Applicants respectfully submit that the rejection of claims 27 and 28 be withdrawn.

4. Claim 31

As described above, Applicants respectfully submit that Hunter fails to disclose, teach, or suggest at least the features of a processor configured to **"select without user intervention, a portable storage medium type from the plurality of portable storage medium types and at least one of the portable storage mediums of the selected portable storage medium type, the selected portable storage medium type and the selected at least one of the portable storage mediums corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content"** as recited in claim 1. The addition of Russo fails to remedy these deficiencies. Since dependent claim 31 incorporates these same features found in independent claim 1, Applicants respectfully submit that claim 31 is allowable over Hunter

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int'l Co. v. Teleflex, Inc. (KSR)*, No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int'l Co.*, at 14, 15. This requirement prevents the use of "the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight." *Ecolchem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants submit that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). It would not have been obvious to one of ordinary skill in the art to combine Hunter in view of Hassell, LaJoie, Browne or Russo. Applicants earnestly request reconsideration, withdrawal of these rejections, and allowance of claims 12, 13, 16, 18, 26, 27, 28 and 31.

Conclusion

In this response, claim 1 is amended. Subsequent to this response, claims 1-31, 58 and 59 remain pending. No new matter is believed to be added by this response. Applicants submit that all of the claims are now in a form for allowance. Thus, Applicants respectfully request allowance of all the pending claims.

No fee is believed due beyond the fee for the accompanying Request for Continued Acceleration; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

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